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PATENT
Attorney Docket No.: A-63463-1/RFT/RMS/RMS
Attorney File No.: 467720-00004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Tor *et al.*

Serial No. 08/648,270

Filed: May 15, 1996

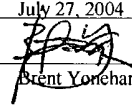
For: *Substituted Phenanthrolines*

Examiner: Lawrence E. Crane
Supervising Examiner: James O. Wilson
Art Unit: 1623

CERTIFICATE OF MAILING AND FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being delivered by facsimile transmission to [703] 872-9306 and being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Supervising Examiner James O. Wilson, Technology Group 1600, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450 on:

Date: July 27, 2004

Signed: 
Brent Yonchara

SECOND STATUS INQUIRY RE APPEAL BRIEF

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P.O. Box 1450
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AUG 05 2004

TECH CENTER 1600/2900

Sir:

Applicants are requesting a status update on an Appeal Brief filed November 21, 2001. As Applicants have not received a Notice of Noncompliance as required under 37 CFR § 1.192(d), Applicants assume that the Brief as filed complied with the requirements under 37 CFR § 1.192(c). It is Applicants understanding that they should have received an Examiner's Answer within 2 months after receipt of the brief. *See* M.P.E.P. § 1208. The Answer should indicate that an Appeal Conference was held. An Appeal Conference is mandatory in all cases in which an acceptable brief has been filed. *See* M.P.E.P. § 1208.

On April 10, 2003, after several telephone messages, Applicants were informed by Examiner Crane that an Appeal Conference would be held during that current quarter (*i.e.*,

Spring 2003). Applicants never received an Answer pursuant to M.P.E.P. § 1208, and accordingly, Applicants assume that an Appeal Conference was never held.

On October 3, 2003, Applicants filed an Appeal Brief Status Request. No response was ever received responding to this status inquiry.

On July 26, 2004, Applicants again telephoned Examiner Crane regarding the status of the application. On July 27, 2004, he responded, stating that “he was not sure what he was going to do at this point.” In addition, he stated there is a “possibility that it [the application] will be withdrawn from appeal, and another office action will be mailed.” However, no definitive action appears to have been made, to date, on this application.

In the absence of the Examiner’s answer, Applicants’ application remains in the jurisdiction of the Technology Centers. Applicants note if the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences, and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. The period of extension includes any period beginning on the date on which the appeal was filed.

In the present case, the appeal was filed on November 21, 2001, *see* M.P.E.P. § 2720, and forwarded to Examiner Crane on January 2, 2002 for review. More than two years have passed without any action occurring on Applicants’ Brief. Applicants note that the application has been pending for over eight (8) years and has received significantly more than three (3) office actions, thus the Patent Office’s inaction does not expedite prosecution as set forth in M.P.E.P. § 707.02. The Patent Office’s inaction, coupled with a lengthy appeal process will significantly shorten the term of patent, if a patent should issue. Accordingly, Applicants request resolution of this application through confirmation that either: 1) the

application is on appeal with the Board of Patent Appeals and Interferences; or 2) a subsequent office action is to be mailed shortly.

Although the Applicants do not believe any additional fees are required, the Commissioner is authorized to charge any additional fees, including extension fees or other relief, which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 467720-00004 (A-63463-1/RFT/RMS/RMK)).

Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: July 27, 2004

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